

REMARKS

A. Restriction Requirement

In the Office Action mailed on May 3, 2004, affirmation of the election of claims 1-22 was requested. Accordingly, Applicants affirm that claims 1-22 have been elected for prosecution in the present application.

Note that claims 23-33 have been canceled in order to expedite prosecution of the present application since the claims were not elected for prosecution. Applicants reserve the right to file claims 23-33 in a divisional application. Accordingly, the cancellation of claims 23-33 is not being done for reasons of patentability as defined in *Festo Corporation v. Shoketsu Kinzoku Kogyo Kabushiki Co., Ltd.*, 234 F.3d 558, 56 USPQ2d 1865 (Fed. Cir. 2000) (*en banc*), *overruled in part*, 535 U.S. 722 (2002).

B. 35 U.S.C. § 103

1. Wong

Claims 1, 3-6 and 8 were rejected under 35 U.S.C. § 103 as being obvious in view of Wong. Claim 1 has been amended to clarify that the generated business decision "is made solely by an electronic data processing system without the need for manual data entry into or manual data extraction from the electronic data processing system." In contrast, Wong is directed to business-to-business web commerce and business automation system that still relies on an individual to make a business decision, such as buying a product, and manually entering that decision into the system (Col. 14, ll. 29-52). Wong clearly desires to have a human decision involved with the generation of a business decision. Since Wong does not disclose nor suggest the generation of a business decision

made solely by an electronic data processing system as defined in claim 1, the rejection is overcome and should be withdrawn.

On a related matter, it is noted that the Office Action has relied on various passages in the claims of Wong to show that Wong describes various element of claim 1. However, a review of the passages shows that they do not disclose what is being asserted in the Office Action. For example, the Office Action asserts that claim 1's recitation "automatically transmitting the obtained requirement-indicating data from a first business entity to a second business entity over a communications network" is fully disclosed at col. 45, lines 24-27 of Wong. However, the passage states:

[A] user making modifications to a record within a file belonging to the first business domain, the database management system in response thereto automatically reflecting said modifications within files belonging to the second business domain.

The passage does not mention "requirement-indicating data" and "a communications network." There are numerous other instances where the Office Action relies on passages that do not reflect the subject matter that they are being used to reject the claims. In view of the improperness reliance on these passages, Applicants demand that the next Office Action point out to specific text and drawings that describe the various embodiments of Wong that are used to reject the claims. If no such specificity is provided, then that should be taken as evidence that the rejection has no merit.

2. Wong and Huang et al.

a. Claims 2, 7, 9 and 10

Claims 2, 7, 9 and 10 were rejected under 35 U.S.C. § 103 as being obvious in view of Wong and Huang et al. Applicants traverse this rejection. In particular, claims 2, 7, 9

and 10 depend directly or indirectly on claim 1. As mentioned above in Section B.1, Wong does not disclose nor suggest the generation of a business decision made solely by an electronic data processing system as defined in claim 1. Huang et al. is directed to a system for the management of a supply chain. There is no suggestion in Huang et al. to alter Wong's process/structure so that generation of a business decision made solely by an electronic data processing system as defined in claim 1. Without such suggestion the rejection should be withdrawn.

The rejection of claim 7 is traversed because neither Wong nor Huang et al. disclose extracting a subset of the requirement-indicating data from a requirement-indicating database associated with an enterprise resource planning system. The Office Action relies on the passages at column 10, lines 45, 46, 49 and 50 of Huang et al. as disclosing the claimed extracting. However, the passages do not disclose extracting in any way as shown below:

In the DSS Database 12 for these chains is as follows:

Aggregate Production Plan Data: Aggregate Production Plan

Requirement Data; Component Requirement Header; Component Supplier; Component Supply Contract; Component

Since the passages do not disclose nor suggest extracting as recited in claim 7, the rejection is improper and should be withdrawn.

Note that claim 7 has been amended to correct an obvious typographical error. Since the amendment does not change the intended meaning or scope of the claim, the amendment is not related to patentability as defined in *Festo*.

b. Claims 11-13 and 18-22

Claims 11-13 and 18-22 were rejected under 35 U.S.C. § 103 as being obvious in view of Wong and Huang et al. Claim 11 has been amended to clarify that the generated business decision “is made solely by an electronic data processing system without the need for manual data entry into or manual data extraction from the electronic data processing system.” As mentioned above in Section B.1, Wong is directed to business-to-business web commerce and business automation system that still relies on an individual to make a business decision, such as buying a product, and manually entering that decision into the system (Col. 14, ll. 29-52). Since Huang et al. also does not suggest altering Wong’s process/structure so that generation of a business decision made solely by an electronic data processing system as defined in claim 11, the rejection is overcome and should be withdrawn.

Note that claims 13 and 22 have been amended to correct an obvious typographical error. Since the amendment does not change the intended meaning or scope of the claim, the amendment is not related to patentability as defined in *Festo*.

3. Wong, Huang et al. and Bowman-Amuah

Claims 14-17 were rejected under 35 U.S.C. § 103 as being obvious in view of Wong, Huang et al. and Bowman-Amuah. Applicants traverse this rejection. In particular, claims 14-17 depend directly or indirectly on claim 11. As mentioned above in Section B.11, Wong and Huang et al. each do not disclose nor suggest altering Wong so that the generation of a business decision is made solely by an electronic data processing system as defined in claim 11. Bowman-Amuah does not cure the deficiencies of Wong and Huang et

al. since it does not suggest altering Wong's process/structure so that generation of a business decision made solely by an electronic data processing system as defined in claim 11. Without such suggestion the rejection should be withdrawn.

Note that claims 14 and 17 have been amended to correct an obvious typographical error. Since the amendment does not change the intended meaning or scope of the claim, the amendment is not related to patentability as defined in *Festo*.


C. New Claims 34-37

New claims 34-37 are being presented to provide additional coverage for the method of claim 1. Accordingly, new claims 34-37 are not being presented for reasons of patentability as defined in *Festo Corporation v. Shoketsu Kinzoku Kogyo Kabushiki Co., Ltd.*, 234 F.3d 558, 56 USPQ2d 1865 (Fed. Cir. 2000) (*en banc*), *overruled in part*, 535 U.S. 722 (2002).

CONCLUSION

In view of the arguments above, Applicants respectfully submit that all of the pending claims 1-22 and 34-37 are in condition for allowance and seeks an early allowance thereof. If for any reason, the Examiner is unable to allow the application in the next Office Action and believes that an interview would be helpful to resolve any remaining issues, he is respectfully requested to contact the undersigned attorneys at (312) 321-4200.

Respectfully submitted,



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